

REQUEST FOR RECONSIDERATION

Upon entry of this amendment, claims 1-5 and 11-29 will remain active in this application.

The present invention is directed to a method of treating hair.

Improvements in hair feel and stylability are generally sought. Conventional methods of applying hair treatments to shampooed **wet hair** are not always entirely effective. Effective methods would be welcome.

The present invention addresses this issue by providing a method of conditioning hair by applying a hair treatment composition consisting essentially of 0.5 to 25 % by weight of at least one oil agent, a solvent, and having a water content of 0 to 15 % by weight to dry hair, letting stand, then washing away. Applicants have discovered that such a method is effective in conditioning hair. Such a method is nowhere disclosed in the cited prior art of record.

The rejection of claims 1, 11-13, 15, 20-21, 23 and 28 under 35 U.S.C. § 102(b) over Matsunaga et al. U.S. 4,495,173 is respectfully traversed.

Matsunaga et al. fail to describe a hair treatment method in which a composition consisting essentially of 0.5-25 wt. % of at least one oil agent, a solvent and 0-15 wt. % of water is used.

Matsunaga et al. describes a pre-shampoo type hair treatment comprising decomposition derivatives of keratin material and cationic polymer (column 1, lines 7-10). The composition is prepared **by dissolving or suspending** the decomposition derivative of keratin material, cationic polymer, and other known components, in a medium such as **water** (column 8, lines 29-39). As noted by the examiner, various formulations are illustrated, identifying specific quantities of oil agent and solvent, however it is noted that in no case is the identity of more than 13.5 wt. % of the formulation provided. There is no disclosure of an

amount of water of from 0-15 wt. %. Quite to the contrary, the specification describes the preparation of the composition by dissolving or suspending in **water**. As such the reference clearly does not disclose or suggest a composition containing 0 to 15 wt. % of water.

In contrast, the claimed method is practiced with a composition containing only 0 to 15 wt. % of water. This is a claim limitation which is simply not disclosed or suggested in the reference. Moreover the rejection fails to identify how this claim limitation is met by the reference. As the reference fails to describe the claim limitation of an amount of water of from 0 to 15 wt. % and to the contrary describes preparation of the composition as a solution or suspension in water, the claimed invention is clearly neither anticipated nor made obvious by this reference. Withdrawal of the rejection under 35 U.S.C. § 102(b) is respectfully requested.

The rejections of claims 1, 3 and 11-27 under 35 U.S.C. 103(a) over Komori et al. U.S. 5,342,611 alone, and in view of Okumura et al. U.S. 4,402,936 and of claims 2, and 4-5 under 35 U.S.C. 103(a) over Komori et al. U.S. 5,342,611 alone, and in view of Okumura et al. U.S. 4,402,936 and further view of Priest et al. U.S. 4,296,763 are respectfully traversed.

A hair conditioning method in which the hair treatment composition consists essentially of 0.5 to 25 % by weight of at least one oil agent, a solvent, **and** having a water content of 0 to 15 % by weight, is nowhere disclosed or suggested in the cited references.

Komori et al. has been cited by the examiner as describing a hair treatment composition as claimed. This reference describes a hair **cleansing** composition comprising (a) a surfactant, (b) an alcohol, (c) 0.1 to 25 % of water, and (d) 20 to 98 wt.% of a liquid oil (see abstract). The reference describes that the claimed composition may be used in methods as diverse as shampoo, a preshampoo, a hair-make remover, a dandruff remover (column 5, lines 13-15) and exemplifies these compositions as well as a hair cleanser and a point-set remover. There is no suggestion in the reference to use a composition which meets each of the claim limitations of 1)

0.5 to 25 % by weight of at least one oil agent and 2) a water content of 0 to 15 % by weight, at the same time, **in a method of conditioning hair by applying to dry hair.**

Applicants note that the reference describes use of the claimed hair cleaning composition for a variety of uses, such as a shampoo, a preshampoo, a hair-make remover, a dandruff remover, a hair cleanser and a point-set remover. Many these methods do not suggest applying the composition to condition hair by applying to dry hair. The examiner has **only** identified the use of a preshampoo as suggestive of the claimed method in which the composition is applied to dry hair (page 5, line 7-8 of outstanding official action). Accordingly, only the use of the reference composition as a preshampoo is asserted as making the claimed method obvious.

However, the reference does not suggest using a preshampoo composition which contains 0.5 to 25 % by weight of at least one oil agent and a water content of 0 to 15 % by weight. For example the reference identifies a number of compositions, for specific purposes. Example 1 is identified as a hair cleaner. Examples 2 and 8 are identified as hair-make removers. Examples 3 and 9 are identified as point-set removers. Examples 4 and 10 are identified as dandruff removers. Examples 5 and 11 are identified as preshampoos. Examples 6, 7 and 12 are identified as shampoos. In no instance is any single composition identified as suitable for all of the asserted uses. To the contrary, the reference suggests specific compositions as only suitable for specific uses.

In the only compositions asserted by the examiner as suggestive of the claimed method (the preshampoos of examples 5, 11(a) and (b)), the compositions contain at least 85 wt. % of oil and 8.0 wt. % of water (example 5), 20 wt. % oil and 50 wt. % water (example 11(a)); and 18.5 wt.% oil and 45 wt. % water (example 11(b)). Accordingly, then the amount of water is less than 15 wt. %, the amount of oil exceeds the claimed 25 wt. % maximum. Conversely, when the amount of oil is within the claimed 0.5 to 25 wt. % range, the water level exceeds the

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maximum amount of 15 wt. %. For the preshampoo compositions described in the reference, there is a more specific teaching of having at least an amount oil in excess of 25 wt. % or an amount of water in excess of 15 wt. %. Accordingly there is no suggestion of a preshampoo composition having both 0.5 to 25 wt. % of an oil and 0 to 15 wt. % of water.

The basic deficiencies of the primary references are not cured by any of the remaining references of Okumura et al., Priest et al. or Hulett et al.

Okumura et al. has been cited by the examiner as describing the conventional use of a preshampoo by applying an oil containing composition to dry hair for five minutes followed by washing. Applicants note that Okumura et al. clearly identifies the conventional use of a preshampoo composition which contains **more than 15 wt. % water**. At column 3, lines 53-55 of the reference, is a disclosure that the balance of the composition is water. Each of the examples identify the amount of water as being "balance" or 96 wt. %. In the compositions in which water is "balance" no more than 24 wt. % of other components are identified, making clear that an amount of water in excess of 15 wt % is disclosed.

As Komori et al. does not describe limitation of the amount of water to 15 wt. % or less and having the amount of oil from 0.5 to 25 wt. % **in a preshampoo composition** and the exemplary reference cited by the examiner as the conventional use of a preshampoo composition contains an amount of water far in excess of the claimed 15wt. % maximum, the claimed method in which a composition consisting essentially of 0.5 to 25 wt. % of oil, a solvent and 0 to 15 wt. % of water is applied to dry hair is simply not suggested.

Priest et al and Hulett et al. have been cited by the examiner for their teaching of the use of a covering in a hair treatment method. However, neither of these references suggests the claimed hair treatment composition consisting essentially of 0.5 to 25 wt. % of oil, a solvent and 0 to 15 wt. % of water. Therefore, these additional references fail to render the claimed invention obvious.

For this reason, the claimed invention would not have been obvious from these references. Withdrawal of the rejections under 35 U.S.C. § 103(a) is respectfully requested.

The rejection of claims 1-5, 11-5, 19, 23 and 28-29 under 35 U.S.C. 103(a) over Namba et al U.S. 5,286,476 in view of Andersin GB 824,353, in further view of Priest et al. is respectfully traversed.

Nowhere is the cited references is it suggested to apply a composition consisting essentially of 0.5 to 25 wt. % of oil, a solvent and 0-15 wt.% of water, to dry hair followed by washing away the hair treatment composition.

Namba et al describes a hair cosmetic composition which imparts a smooth feeling to hair, has an excellent effect at **preventing** the generation of split hair and torn hair and repairs split ends (column 2, lines 5-9). The composition is applied to hair and remains thereon in order to provide the preventive effects of generating split ends. This is explicit from the evaluation test in which the composition is applied to hair, and subjected to brushing to measure the prevention of forming split ends (column 12, lines 54-63). The fact that this composition is to be left in the hair is implied by the presence of U.V. absorbers in the composition, to protect the hair (column 7, lines 38-46). If there were motivation to wash the composition out of the hair, there would be no reason to include a U.V. absorber. There is no washing step suggested.

The examiner cites to Andersin asserting that this reference describes the conventional use of hair oil in which the composition is applied to hair and washed away. However the composition of Andersin is much different from that of the compositions of Namba et al. such that the explicit teaching of Namba et al to leave the hair cosmetic composition in the hair can not be ignored. Quite simply to wash away the hair cosmetic composition of Namba et al would not be obvious as to do so would destroy the operability of the reference. The composition of

Namba et al must be left on the hair in order to provide the benefits as described. To wash away the composition would not be obvious.

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so."(In re Fritch 23 USPQ2d 1780 1783 (Fed. Cir. (1992))).

The lack of relevancy of Priest et al. as it applies to the present rejection is made clear by applicants argument made in the prior rejection in which Priest et al was applied. The reference does not suggest a washing out step for the composition of Namba et al. Withdrawal of the rejection under 35 U.S.C. 103(a) is respectfully requested.

The rejection of claims 1-5 and 11-29 under 35 U.S.C. 112, second paragraph is obviated in-part by amendment and traversed in-part.

Applicants have now amended claims 1 and 3 as suggested by the examiner to further clarify that the amount of oil is 0.5 to 25 wt. %.

As to the meaning of the term "consisting essentially of", this limits the scope of the claim to the specified materials and those that do not materially affect the basic and novel characteristic of the claimed invention (MPEP 211.03). As the invention is directed to a method of treating hair for improving feel or stylability (page 1, lines 22-24 of applicants' specification" the metes and bounds of the present invention are clear to those of ordinary skill in the art. Withdrawal of the rejection under 35 U.S.C. 112, second paragraph is respectfully requested.

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Applicants submit that this application is now in condition for allowance and early notification of such action is earnestly solicited.

Respectfully submitted,

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